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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,618	06/13/2000	Jay S. Walker	00-012	5604

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WALKER DIGITAL
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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3639

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,618

Applicant(s)

WALKER ET AL.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28,30-53,59-64 and 81-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28,30-53,59-64 and 81-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the following method step: "*charging the price* to a customer associated with the first transaction". However, according a dependent Claim 13, the price can be "a non-monetary amount", or "an agreement of a customer to use a designated financial account". It is not clear how one can be *charged* with a *non-monetary amount* or *with an agreement*.

The remaining Claims are rejected as being dependent on Claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-9, 11-25, 28, 30-33, 35-38, 40-44, 46-53 and 59-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams (US 2002/0049631).

Williams teaches a method for providing purchasing incentives to a plurality of retail store environments, comprising:

Independent Claims

As per claim 1,

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- receiving information relating to a first transaction [0020];
- determining a benefit, said benefit based at least in part on said information [0013]; [0020];
- determining a price/value of said benefit [0038];
- charging the price to a customer (the customer qualifies for the benefit by having made qualified purchases) [0013];
- applying said benefit during a second transaction [0063].

As per claim 30,

- receiving information relating to a transaction [0020];
- determining a benefit and a qualifying action for said benefit, said benefit based at least in part on said information [0020]; [0038];
- determining a price/value of said benefit [0038];
- selling said benefit at said price to a customer (the customer qualifies for the benefit by having made qualified purchases) [0013];
- applying said benefit during a second transaction [0063].

As per claims 47 and 49,

- conducting a transaction for a purchase of a first service [0020];
- determining a benefit during said transaction, said benefit associated with a future purchase of a second service, [0020]; [0038];
- providing to a customer said benefit at said price during said transaction, thereby charging the price to the consumer (the customer qualifies for the benefit by having made qualified purchases) [0013];
- applying said benefit during a second transaction [0063].

As per claims 51 and 52,

- receiving information relating to a first transaction [0020];
- determining a benefit, said benefit based at least in part on said information [0013]; [0020];
- determining a value of said benefit [0038];
- providing to a customer said benefit at said price during said transaction, thereby charging the price to the consumer (the customer qualifies for the

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benefit by having made qualified purchases) [0013];

- applying said benefit during a second transaction [0063].

As per claim 53,

- receiving information relating to a first transaction [0020];
- determining a benefit [0013]; [0020];
- selling to a customer said benefit for said price during said first transaction,

thereby charging said price to the customer (the customer qualifies for the benefit by having made qualified purchases) [0013];

- applying said benefit during a second transaction [0063].

As per claim 59,

- determining at least one product being purchased by a customer during a first transaction [0020]; [0038];

- determining a price for said at least one product being purchased during said first transaction [0020]; [0038];

- offering said customer an opportunity to purchase said at least one product during a second transaction at said price [0020]; [0038];

- receiving an acceptance of said offer from the consumer by receiving a payment for the opportunity (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013];

- applying said benefit during a second transaction [0063].

As per claims 63 and 64,

- determining at least one product being purchased by a customer during a first transaction [0020]; [0038];

- determining a price for said at least one product being purchased during said first transaction [0020]; [0038];

- determining a benefit and a value of said benefit [0020]; [0038];

- providing said customer a benefit during said first transaction, wherein said benefit allows said to purchase said at least one product during a second transaction at said price [0020]; [0038];

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- charging said customer for a cost of the benefit (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013];
- applying said benefit during a second transaction [0063].

Dependent Claims

Furthermore, Williams teaches,

As per claims 2 and 32, said method, further comprising at least one of the following: retrieving benefit information; offering said benefit for sale at said price; receiving an indication of a purchase of said benefit; and receiving an indication of a customer's agreement to purchase said benefit [0037] - [0039].

As per claims 3 and 33, said method, further comprising at least one of the following: determining an available subsidy; receiving a subsidy amount; and determining a margin between a price and a subsidy amount [0040]; [0051]; [0052].

As per claims 4 and 31, said method, further comprising:

- verifying usability of said benefit during said second transaction [0020] - [0022]; [0037] - [0039].

As per claims 6 and 35, said method, further comprising at least one of the following: establishing a condition on said benefit; determining a condition associated with said benefit; and providing an indication of a condition associated with said benefit [0020] - [0022].

As per claims 7 and 36, said method, further comprising at least one of the following: receiving an indication of a receiver of said benefit; canceling said benefit; changing said benefit; and redeeming said benefit [0020] - [0022].

As per claims 8 and 37, said method, further comprising at least one of the following: receiving a customer identifier; receiving a group identifier; receiving a customer device identifier; receiving a payment identifier; receiving a retailer identifier; receiving a benefit identifier; receiving a service identifier; and receiving a product identifier [0031] - [0035].

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As per claims 9 and 38, said method, further comprising at least one of the following: redeeming a previously determined benefit; receiving a request to redeem said benefit; aggregating said benefit with a previously determined benefit [0006]; [0019]; [0022].

As per claims 11-12 and 40, providing a list of at least two benefits; receiving an indication of a selection of one of said at least two benefits; receiving an indication of at least one person to whom said benefit is to be provided [0037] - [0039].

As per claims 13, 19, 20-22, 46, 48 and 50, see reasoning applied for claims 1, 30, 49 and 86.

As per claims 14, 15 and 41, associating a qualifying action (purchasing an identified product) with said benefit [0020]; [0038].

As per claims 16-17 and 42-44,

- receiving an indication of a completion of said qualifying action [0024]; [0038];
- providing said benefit after receiving said indication [0024]; [0038];
- arranging for said benefit to be provided after receiving said indication [0024]; [0038].

As per claim 18, said method, wherein said transaction information includes a customer identifier [0037].

As per claim 23, said method, wherein said benefit is a previously determined benefit [0039].

As per claims 24 and 25, providing a receipt (coupon) to a customer, wherein said receipt includes a benefit identifier [0022].

As per claim 28, said method, wherein said benefit cannot be applied during said first transaction [0022].

As per claims 60-62, providing said customer a benefit identifier [0047].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 81-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Nilssen (US 6,017,063).

Independent Claims

As per claim 81, Williams teaches:

- determining a first price for which a product (a unit of a product) is being purchased as a part of a first transaction at a point of sale terminal [0020]; [0038];
- determining a benefit for the future second transaction [0013]; [0020];
- outputting, at the point of sale terminal, an offer to sell the benefit for a second price [0020]; [0038];
- charging a customer for a cost of the benefit (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013].

Williams does not specifically teach that said benefit comprises a guarantee that no more than the first price for a second unit of the product will be charged if the second unit of the product is purchased as part of a second transaction.

Nilssen teaches a method and system for a financial certificates, wherein a financial coded certificates denominated in pricing units of a product is sold to a customer; said certificate represents a certain amount or a certain number of merchandise units; which amount of merchandise will be delivered to the bearer of the certificate in exchange therefor. Specifically, the holder of such a certificate is entitled to exchange this certificate, at any later time, for said product equivalent in total pricing units to the denomination specified on the certificate, regardless of any intervening changes in dollar pricing of said product (C. 1, L. 42-46; C. 2, L. 44-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that said benefit comprises a

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guarantee that no more than the first price for a second unit of the product will be charged if the second unit of the product is purchased as part of a second transaction, as disclosed in Nilssen, because it would advantageously allow customer to obtain said product in the future at the same price regardless of inflation (Nilssen, C. 1, L. 39-40).

As per claims 85 and 86, Williams teaches:

- determining a purchase total for a first transaction including a plurality of products [0020]; [0038];
- determining a benefit for the future second transaction [0013]; [0020];
- outputting, at the point of sale terminal, an offer to sell the benefit for a price [0020]; [0038];
- charging a customer for a cost of the benefit (the customer qualifies for the benefit by having made qualified purchases; conducting qualified purchases by the customer indicates the acceptance of said offer by the consumer) [0013].

Williams does not specifically teach that said benefit comprises a guarantee that an amount that is not greater than the purchase total will be charged for the plurality of products during a second transaction.

Nilssen teaches a method and system for a financial certificates, wherein a financial coded certificates denominated in pricing units of a product is sold to a customer; said certificate represents a certain amount or a certain number of merchandise units; which amount of merchandise will be delivered to the bearer of the certificate in exchange therefor. Specifically, the holder of such a certificate is entitled to exchange this certificate, at any later time, for said product equivalent in total pricing units to the denomination specified on the certificate, regardless of any intervening changes in dollar pricing of said product (C. 1, L. 42-46; C. 2, L. 44-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include that an amount that is not greater than the purchase total will be charged for the plurality of products during a second transaction, because it would advantageously allow customer to obtain said product in the future at the same price regardless of inflation (Nilssen, C. 1; L. 39-40).

Dependent Claims

As per Claims 82-84, see reasoning applied to Claim 81.

As per Claim 87, see reasoning applied to Claim 86.

Claims 5, 10, 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Walker et al. (US 5,970,470).

Dependent Claims

As per claims 5, 10, 34 and 39, Williams teaches all the limitations of claims 5, 10, 34 and 39, except teaching imposing a penalty or reducing the benefit if a customer does not complete a specific future transaction.

Walker et al. (Walker) teaches a method for establishing and managing subscription purchase agreements, wherein a customer's account may be assessed a penalty in the event that the customer does not honor the purchase terms and conditions (C. 2, L. 63 – C. 3, L. 4).

It would have been obvious to one having ordinary skill in the art to modify Williams to include imposing a penalty if a customer does not complete a specific future transaction, as disclosed in Walker, because it would advantageously allow to minimize losses incurred by vendors who provide benefits for their customers.

Claims 26-27 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Mindrum et al. (US 4,723,212).

Dependent Claims

As per claims 26-27 and 45, Williams teaches all the limitations of claims 26-27 and 45, except that the benefit is transferable, and wherein said benefit can be shared by a plurality of people.

Mindrum et al. (Mindrum) teaches a method for dispensing discount coupons, wherein said coupons are distributed to different groups of customers (C. 1, L. 25-54).

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It would have been obvious to one having ordinary skill in the art to modify Williams to include that the benefit is transferable and can be shared by a plurality of people, as disclosed in Mindrum, because it would advantageously attract new customers, thereby increase revenue.

Response to Arguments

Applicant's arguments with respect to Claims 1-28, 30-53, 59-64 and 81-87 have been considered but are moot in view of the new ground(s) of rejection.

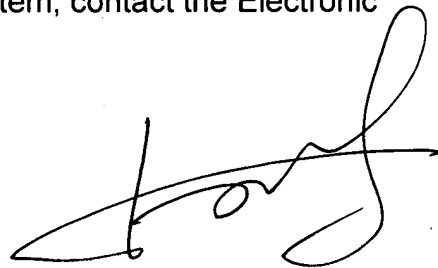
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov
Patent Examiner
Art Unit 3639



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10/31/2005